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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

GARG, YOGESH C

ART UNIT PAPER NUMBER

3625

DATE MAILED: 07/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/540,011

Applicant(s)

KIGHT ET AL.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 & 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. Preliminary amendments A, paper number 4, and B, paper number 5 received on 03/31/2000 are entered. Claims 1-35 have been cancelled. Currently claims are 36-50 are pending for examination.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "42" and "47" have both been used to designate Merchant Master File. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. Claims 37-38, and 47-48 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. With regards to claims 37 and 47, the limitation, " searching a master merchant database containing merchants received from other consumers to determine if a merchant on the list received from the consumer is included in the master merchant database " is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosure teaches searching the consumer's MMF only (Specification, Page 7, lines 7-9,

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"..Through athe consumer may access **his merchant list....**", and lines 17-20, "...By telephone.....if a particular merchant (selected from the **consumer's MMF**, which may be updated from time to time).....") at the time of receiving a request for bill payment. Since claims 38 and 49 are dependencies of claims 37 and 48 respectively, they are also rejected. Note: In view of this 35 U.S.C. 112, first paragraph rejection the limitation of searching master merchant database, at the time of receiving a request for bill payment from the consumer, will be restricted to searching the consumer's MMF file only for further art rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 36-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor et al. (US Patent 5,220,501) further in view of Huber (US Patent 4,791,561).

With regards to method claims 36-40, Lawlor teaches receiving, via a network, a request to pay a bill associated with a merchant on behalf of the consumer, a list of merchants, searching a master database of merchants, also containing list of merchants received from other customers, to determine if the merchant is included in the master database of merchants and processing the request to generate an instruction to pay the bill (col.18, line 18-col.23, line 8, "*Central computer 52 also electronically communicates with additional remote data processing systemsACH 72.....dialup telephone lines...The link with wholesales and*

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remittance processors 78 permits the payment of bills...pays payees.....Central computer 52 is programmed...to perform various bill paying.....and other services to remote terminals 54 on demand....Conventional banking software packages....perform a variety.....functions ...Conventional database handling functionsThe banking module 80H is conventional and permits customers to pay billsThe module 80H maintains customer database files, vendor files and transaction files.....customer service reports.....". Note: Remote terminals 54 correspond to consumers, payees correspond to merchants, and module 80H includes merchant databases. In col.32, line 67- col.34, line 45, "...The main menu of services.....(bill paying.....).....When bill payment is selected from the main menu.....terminal 54 displays a unique list of payeesAfter selecting one payee.....", list of payees correspond to merchant database and selection of a payee denotes to determine if the merchant is included in the merchant database. Also see col.41, line 61-col.49, line 40, "....If the user selects the " pay bill" option.....a flow chart of which is shown in FIG.13.....routine 392 performs the function of processing, reviewing and correct billing information...Referring now more particularly to FIGS. 14A-14C, the "bill pay" routine 506 processes bill paymentsdisplay a list of payees.....Such user-specific information is stored by central computer 52storage device 84 and is accessed by FIG.14 A block 516 to display a list of payees..... may constitute a listing of categories of payees rather than individual payees ..If the user does not select one of the displayed payees....attempts to display the "next" or previous" 4 -payee sublist.....").

Lawlor further discloses receiving a plurality of payment records, each of the plurality of payment records including a merchant to whom payment has been made (col.10, line 66-col.11, line 21, and col.42, line 68-col.43, line 24 teach receiving plurality of payment information and records from the consumer, including a merchant to whom the payment has been made.

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Further, col.43, lines 48-68 also disclose receiving a payment records from an output file- "In the preferred embodiment, decision block 526 scans through the output file to determine whether the user has already requested a transaction.....to the same payee (block 528)".

Lawlor does not disclose adding a merchant to the master merchant database if the merchant is not included in the master merchant database, at the time of the search. This limitation relates to the functioning of database. Huber teaches the operation of data processing systems, management and upgrading of relational databases while under interactive use (col.1, lines 13-17). Huber further discloses adding a record (pertaining to adding a merchant), if it is not there (col.1, lines 25-37, col.2, lines 64-68, col.3, lines 22-29, col.3, lines 46-62, col.4, 9-19, col.7, line 57-col.8, line 6, col.10, lines 6-25, and col.11, lines 40-54). In view of Huber, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to combine Huber's concept of adding a record (merchant) if it is not found in the database. Doing so would help in updating the consumer's merchant database by adding new merchants and further allowing the system to continue to provide services of bill payment to the consumers for their new merchants/payees and to accommodate changes in the names of merchants/payees.

6. With regards to system claims 41-45, and article of manufacture claims, 46-50, their limitations correspond to the limitations of method claims 36-40 and they are analyzed and rejected similarly, as above.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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(i) US Patent 4,948,174 to Thomson et al., US Patent 4,948,174 to Josephson and US Patent 5,093,787 to Simmons disclose bill payment and on-line electronic funds transfer.

Thomson also discloses database design to contain details about customer's accounts, such that the information can be retrieved, new customers can be added and old customers can be deleted (col.8, line 64-col.9, line 10).

(ii) Blattberg, Robert C.; Deighton, John, "Interactive Marketing: Exploiting the Age of Addressability", Sloan Management Review, vol.13, no.1, Fall 1991, p5-14 disclose maintaining interactive relationships with customers by using database and the innumerable advantages of transactional databases.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg
Examiner
Art Unit 3625

YCG
July 23, 2002


WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600